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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Texas Instruments Incorporated

Serial No. 76233338

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Before Simms, Hanak, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 30, 2001, Texas Instruments Incorporated (applicant) applied to register the mark shown below on the Principal Register:



The identification of goods and services was ultimately amended to read as follows:

Computer software used for programming digital signal processors in International Class 9

Computer services, namely providing search engines for obtaining data on a global computer network in International Class 42.

The application (Serial No. 76233338) alleges a date of first use and first use in commerce for the goods of January 1, 1998 and for the services of July 1, 1997. The application indicates: "The mark consists of a banner. The first part is shorter and is black. The second part is longer and is red." The application was amended to indicate that applicant "is claiming color as a feature of the mark."

The examining attorney ultimately refused to register applicant's design because it fails to function as a mark under the provisions of Sections 1, 2, 3, and 45 of the Trademark Act. 15 U.S.C. §§ 1051, 1052, 1053, and 1127. After the examining attorney made the refusal final, applicant filed a notice of appeal.

In this case, the examining attorney maintains that applicant's "mark is nothing more than a decorative background for the packaging and website." Examining Attorney's Brief at unnumbered page 6. The examining attorney also points out that "on one page the banner is black and red. On another page, the banner is black, red,

yellow and white. Finally, on yet another web page, the banner is gold, light blue, dark yellow and light yellow. The use of many different colors [in] combinations makes it very difficult for any color to stand out. It is quite evident that there is little or no attempt to promote the color combination of black and red as a trademark and service mark for the goods and services." Examining Attorney's Brief at unnumbered page 8. On the other hand, applicant maintains that its "mark has always been, since the time of its adoption and first use, an inherently distinctive mark that has achieved instant recognition as a trademark denoting the origin of Applicant's goods and services." Applicant's Brief at 8.

Inasmuch as applicant seeks registration on the Principal Register and it has not alleged that its design has acquired distinctiveness, the only issue in this case is whether its design is inherently distinctive.

[T]he question of inherent distinctiveness rests on whether the public in the relevant market would view Pacer's adhesive container cap as a source-identifier. See Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 210 (2000) (stating that a mark is inherently distinctive if its "intrinsic nature serves to identify a particular source" (quoting Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992))); Tone Bros., Inc. v. Sysco Corp., 28 F.3d 1192, 1206 (Fed. Cir. 1994) (Trade dress is inherently distinctive if it "is of such a design that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers").

In re Pacer Technology, 338 F.3d 1348, 67 USPQ2d 1629, 1631 (Fed. Cir. 2003).

The Federal Circuit, the CCPA, and the board have looked to the following factors to determine whether a design is inherently distinctive:

1. Whether the design was "a 'common' basic shape or design, whether it was unique or unusual in a particular field,
2. whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for goods, or
3. whether it was capable of creating a commercial impression distinct from the accompanying words."

Seabrook Foods, Inc. v. Bar-Well Foods, Ltd., 568 F.2d 1342, 196 USPQ 289, 291 (CCPA 1977)(footnotes omitted).

See also Pacer Technology, 67 USPQ2d at 1631; In re Glaxo Group Ltd., 53 USPQ2d 1920, 1922 (TTAB 2000) ("In cases involving the alleged inherent distinctiveness of trade dress, the Board has in the past looked to Seabrook").

Applicant has described its design as "a long rectangle that is divided into two colors (hereinafter the 'Banner'). The first one-fourth of the Banner (the left side) appears in black and the rest of the Banner (the right side) appears in red." Applicant's Brief at 1.

"Applicant also prominently displays its name 'Texas Instruments' on or near the Banner." Applicant's Brief at 8.

The case law suggests that simple background designs such as applicant's here have not been held to be inherently distinctive and they have been registered on the Principal Register only after a showing of acquired distinctiveness, which applicant has not submitted in this case. In re E.J. Brach & Sons, 256 F.2d 325, 118 USPQ 308, 310 (CCPA 1958) ("We do not think that the average consumer of applicant's product will regard its background frills and curves as an unmistakeable, certain, and primary means of identification pointing distinctly to the commercial origin of such product"); In re Anton/Bauer Inc., 7 USPQ2d 1380, 1383 (TTAB 1988) (Applicant's parallelogram background design not shown to have acquired distinctiveness); In re Haggard Company, 217 USPQ 81, 84 (TTAB 1982) (Applicant's black rectangle with a serrated edge not inherently distinctive but registrable under Section 2(f)). Even modifications to these basic designs have not been held to be inherently distinctive. In re Wendy's International, Inc., 227 USPQ 884, 886 (TTAB 1985) ("[A] review of the pertinent case law where designs were held to be inherently distinctive shows those designs to

be, in our view, much more unique and eye-catching than the 'domed rectangle' involved herein"). Therefore, applicant's basic banner design is a simple geometric shape that would not be inherently distinctive. Also, the fact that applicant uses a two-color banner on its website or on packaging for its goods hardly seems inherently distinctive. In re David Crystal, Inc., 296 F.2d 771, 132 USPQ 1, 2 (CCPA 1961) ("[U]nless the design is of such nature that its distinctiveness is obvious, convincing evidence must be forthcoming to prove that in fact the purchasing public does recognize the design as a trademark." Applicant's mark for two parallel red and blue bands for socks not registrable). Applicant's black and red banner is a common, basic shape and the color is hardly eye-catching. A review of the specimens and case law indicates that applicant's design is a simple design that would at best be viewed as a mere refinement of ornamentation used on packaging, advertising, and websites for the goods and services.

"The question whether the subject matter of an application for registration functions as a mark is determined by examining the specimens along with any other relevant material submitted by applicant during prosecution

of the application." In re The Signal Companies, Inc., 228 USPQ 956, 957 (TTAB 1986).

An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a *trademark* with respect to the goods named in the application.

In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976) (emphasis in original, footnote omitted). Applicant's own specimens speak eloquently to the non-distinctiveness of its design. When the specimens are viewed, it is difficult to see that the design serves anything other than a decorative function. In a black-and-white world, the addition of the color red would perhaps be unusual. But in a world of color printing, the presence of the color red on a website or on packaging for software would hardly be noteworthy. The evidence does not support a conclusion that applicant's design on a website or a product's packaging is so inherently distinctive that prospective customers immediately recognize it as a trademark. David Crystal, Inc., 132 USPQ at 2.

Applicant's design is at most a simple refinement of a common rectangle design. In re F.C.F. Inc., 30 USPQ2d 1825, 1828 (TTAB 1994)(footnote omitted) ("While, at best,

applicant's rose design may be unique, in the sense that it is unlike any other floral design, and may serve along with the color red of its packaging as an aid to finding applicant's 'CLARINS' line of cosmetics, its rose design appears to be no more than a mere refinement of a basic, relatively common and well-known form of decoration or ornamentation for cosmetics packaging and would be so regarded by the public").

The final Seabrook factor is whether the design is capable of creating a commercial impression distinct from the words. Applicant admits that it "prominently displays its name 'Texas Instruments' on or near the Banner." Applicant's Brief at 8. Applicant's specimens confirm this usage. It is not clear how applicant's design would be separated from applicant's trademarks such as TEXAS INSTRUMENTS that normally appear in the design. Applicant's design is not similar to the design in its cited case of In re National Institute for Automotive Service Excellence, 218 USPQ 744, 745 (TTAB 1983). In that case the board found that the applicant's "meshed gears design is not a common basic shape; it creates a visual impact separate and apart from the words superimposed thereon (indeed, at a distance the words may be hard to read but the design stands out and provides a means of

ready recognition); it is at most suggestive in nature." Furthermore, inasmuch as applicant does not consistently use the same color pattern on its website, it is not clear why potential users would recognize the particular pattern of this application as a trademark.

Applicant also relies on the case of Knitwaves Inc. v. Lollytogs Ltd., 71 F.3d 996, 36 USPQ2d 1737 (2d Cir. 1995). In its Reply Brief (p.1, emphasis omitted), applicant cites this case for the proposition that "a mark is inherently distinctive, and source-identifying, unless it is shown to have another function which is incompatible or inconsistent with trademark usage." In the Knitwares case, the Second Circuit reversed a decision in favor of the party claiming trademark infringement for a sweater design on the trademark issue because "the design was not primarily intended as source identification." 36 USPQ2d at 1747. The Knitwares case does not address, much less support applicant's argument that its common, decorative design is inherently distinctive.

One final point that applicant raises in its brief (page 6) is "that there are a large number of registrations consisting of simple color designs." Applicant then refers to "selected records from the first 300 records reviewed"

attached to its brief. Id. at 6 n.2.¹ The examining attorney responded by pointing out that each case must be decided on its own merits and that "those registrations are totally different because they included colors, words, and designs, not just color and a design." Examining Attorney's Brief at 8. We add that even "if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). In addition, a review of the registrations that applicant has attached to its brief reveals that many of these registrations are on the Supplemental Register or registered on the Principal Register under the provision of Section 2(f). Inasmuch as the refusal here is simply that applicant's design is not inherently distinctive, these registrations would support the position that applicant's design is not inherently distinctive and that it could not be registered without a showing that the design has acquired distinctiveness.

¹ In his response, the examining attorney refers globally to "prior registrations cited by the applicant in its Office Action response, dated September 5, 2002." At this stage, it is not clear what registrations were submitted on September 5, 2002, but, inasmuch as the examining attorney has not specifically objected to the registrations attached to applicant's brief, we will consider them.

In this case involving applicant's red and black banner design, the record leads us to conclude that buyers would not "immediately rely on it to differentiate the product [and services] from those of competing" producers. Tone Brothers, Inc. v. Sysco Corp., 28 F.3d 1192, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994). Therefore, it is not inherently distinctive.

Decision: The refusal to register the applied-for design on the Principal Register on the ground that it does not function as a mark is affirmed.